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IN THE

Supreme Court of the United States

OCTOBER TERM—1933.

No. 709.

EASTMAN KODAK COMPANY, EASTMAN KODAK COMPANY OF NEW YORK, and EASTMAN KODAK STORES, INC.,

Petitioners,

vs.

CHARLES B. GRAY,

Respondent.

BRIEF FOR PETITIONERS.

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BRIEF OF PETITIONERS.

THE JUDGMENT UNDER REVIEW.

This case is here on writ of certiorari to the United States Circuit Court of Appeals for the Third Circuit to review a judgment (R. 180) reversing a judgment of the District Court of the United States for the Eastern District of Pennsylvania in favor of defendants in a suit to recover damages for patent infringement (R. 157).

OPINIONS OF THE COURTS BELOW.

The opinion of the District Court, written by District Judge William H. Kirkpatrick, was filed July 13, 1932. It appears at page 150 of the record. It has not been reported.

The opinion of the Circuit Court of Appeals for the Third Circuit (Circuit Judges Buffington, Davis, and Thompson), written by Judge Buffington, was filed August 22, 1933. It appears at page 165 of the record and is reported in 67 F. (2d) 190.

JURISDICTION.

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347).

The judgment of the Circuit Court of Appeals for the Third Circuit was entered August 22, 1933 (R. 180). Thereafter a petition for rehearing was filed (R. 181) which was denied, without opinion, on October 31, 1933 (R. 203).

The petition for a writ of certiorari was filed January 8, 1934, and was granted February 5, 1934 (R. 205).

STATEMENT OF THE CASE.

Nature of the Suit.

This is an action at law brought by respondent against petitioners in the District Court of the United States for the Eastern District of Pennsylvania to recover damages for alleged infringement of patent No. 1,314,867 issued to respondent September 2, 1919, on an application filed February 7, 1918. The patent relates to a flexible power-transmitting mechanism, particularly intended for use as a cable release, a well known mechanism for actuating the shutter of a photographic camera.

The Issues Raised by the Pleadings.

The patent contains six claims (R. 206). Petitioners, by plea of the general issue and by notice of special

matters of defense, raised issues of novelty, invention, and infringement with respect to each claim (R. 13, 14, 16, 17, 18, 21). On the trial, respondent relied upon all the claims except claim 4 (R. 20).

The First Trial.

The case was first tried before a jury (R. 19). The jury returned a verdict for respondent (R. 148). Subsequently, on motion of petitioners, this verdict was set aside and a new trial was ordered (R. 149).

Stipulation Waiving Jury on Second Trial.

Following the entry of the order setting the verdict aside and ordering a new trial, the attorneys of record for the parties, by a stipulation in writing, filed with the Clerk of the District Court, agreed to waive a jury on the second trial and to submit the cause for trial and determination by the court (R. 149).

The stipulation provided for submission of the issues "upon the record already made, as if the testimony and exhibits offered in evidence at the trial before Judge Dickinson and a jury had been duly offered in evidence before the Judge who may be assigned to hear this case, subject to any objections which appear on the record." The stipulation also provided that all motions made by either party at the jury trial should be deemed made before the judge trying the case without the intervention of a jury, and that both parties should have the right of appeal as in other cases (R. 149).

Submission of Issues for Trial by the Court.

The cause came on to be heard by a judge of the District Court without a jury upon the pleadings, the evi-

dence, and the arguments and briefs of counsel. In accord with the agreement for use of the record already made, counsel for the respective parties offered in evidence the stenographic notes of testimony and minutes of proceedings taken at the first trial (R. 18, 19).

Opinion of Trial Judge Supporting Judgment for Petitioners.

The trial judge gave judgment for defendants (R. 157). The reasons therefor were stated in an opinion which dealt generally with the issues in dispute (R. 150-156). Near the end of the opinion the trial judge said (R. 155):

> "The statements of fact contained in this opinion may be taken as findings of fact."

The trial judge then proceeded to summarize his findings as follows:

> "1. The combination of closed coil inner thrust member and open coil outer sheath member is not patentable because its elements were known to the prior art and no new mode of operation or functional relationship arises from putting them together."*
>
> "2. Claims 1 and 2 cannot be interpreted as calling for a closed coil inner thrust member in view of the file wrapper history of this patent."
>
> "3. Claims 1 and 2 are anticipated."
>
> "4. Claim 3 is not infringed."
>
> "5. Claims 5 and 6 are invalid because United States patent No. 1,297,327 to Dakin and Underwood

*It is plaintiff's claim that this combination of closed inner and open outer coils is his real contribution to the art (R. 151, 170).

antedating the plaintiff's application discloses the method of attaching the thrust member to the stem claimed, and conclusion, '1' applies to these claims."

The opinion ended with the direction: "Judgment may be entered for the defendant" (R. 156).

Errors Assigned by Respondent on Appeal.

Respondent appealed from the judgment entered in favor of defendants and filed an assignment of errors containing five specifications (R. 158, 159). The first four specifications are directed to the first, second, third and fifth findings quoted in the preceding paragraph.* The fifth specification is addressed to the order directing the entry of judgment for the defendants. The ground of challenge to the finding or order attacked is not stated in any specification. The specifications are general, the style of each being "The learned Trial Judge erred in finding as follows:" followed by quotation of the finding or order complained of.

Respondent's Bill of Exceptions.

Respondent filed a bill of exceptions containing the evidence and minutes of the proceedings before the District Court (R. 18-150). Examination of this bill of exceptions discloses that no request or motion was made, denied, and excepted to, or any like action taken during the progress of the trial, which presented to the trial court the question whether there was support in the evidence for the findings challenged by the assignment of errors or whether the undisputed evidence required contrary findings. The fact is that respondent made no

*The fourth finding,—that claim 3 is not infringed,—was not assigned as error.

request for any findings of fact or for any rulings of law at any time, either during the first trial before the jury, or during the progress of the second trial before the court, or even after the filing of the opinion directing judgment for defendants.

The Motion to Dismiss the Appeal.

Before the appeal was heard, petitioners filed a motion to dismiss the appeal and/or to affirm the judgment (R. 161). The motion was based upon the ground that the assignment of errors presented no question reviewable by the Circuit Court of Appeals in view of the provisions of Sections 649 and 700 of the Revised Statutes (28 U. S. Code, Secs. 773, 875). Decision on the motion was postponed until final hearing (R. 164, 165).

The Decision of the Circuit Court of Appeals.

On final hearing of the appeal, the Circuit Court of Appeals rejected the contention that it had no power to review the findings challenged by the assignment of errors, and, holding that the evidence did not support the findings made by the trial judge but required contrary findings leading to the conclusion that the patent was valid and infringed (R. 177, 179), reversed the judgment entered by the District Court and granted a new trial (R. 180).

SPECIFICATION OF ERRORS.

Petitioners urge that the Circuit Court of Appeals for the Third Circuit erred in the following matters:

1. In holding that it had power to review findings challenged on appeal by respondent's assignment of errors.

2. In holding that the evidence did not support the findings challenged on appeal by respondent's assignment of errors but required contrary findings leading to the conclusion that the patent in suit was valid and infringed.

3. In reversing the judgment entered by the District Court and granting a new trial.

SUMMARY OF ARGUMENT.

In support of the contention that the judgment of the Circuit Court of Appeals for the Third Circuit should be reversed and the judgment of the District Court for the Eastern District of Pennsylvania affirmed, petitioners will urge the following points:

I. The Circuit Court of Appeals had no power to review the findings challenged by the assignment of errors.

II. The findings challenged by the assignment of errors are warranted by the evidence and support the judgment of the District Court.

ARGUMENT.

I.

THE CIRCUIT COURT OF APPEALS HAD NO POWER TO REVIEW THE FINDINGS CHALLENGED BY THE ASSIGNMENT OF ERRORS.

The decision of the Circuit Court of Appeals that it had power to review the findings challenged by respondent's assignment of errors to determine whether the evidence supported the findings or required the trial court

to find the patent valid and infringed is based upon two propositions.

The first proposition is that the findings of the trial court on the disputed issues were not findings of fact, but rulings on questions of law presented by the evidence. This holding is founded upon the view that the issues of invention, novelty, and infringement should be determined as matters of law, and not as questions of fact, where there is no conflict in the evidence introduced to show what the alleged improvement was, what was in the prior art, and what was the nature of the accused devices.

The second proposition upon which the Circuit Court of Appeals based its decision is that there is nothing in the statutes governing review in jury waived cases, or in the state of the record in this case, which prevents review of findings which embody questions of law presented by the evidence.

Petitioners contend that, whatever may be the case, with regard to the issues of anticipation and infringement, the disputed question of invention was one to be determined by the trial court as a question of fact, and not as a matter of law; and that, in any event, the Circuit Court of Appeals had no power to reverse the judgment of the District Court on the ground that the evidence did not support the challenged findings but required findings leading to the conclusion that the patent was valid and infringed, for the reason that no action was taken by respondent to present that question of law to the trial court and secure its ruling thereon during the trial, as required by Sections 649 and 700 of the Revised Statutes (28 U. S. Code, Secs. 773, 875).

The question whether the patentee's alleged improvement required mere mechanical skill or the exercise of the faculty of invention is one of fact, notwithstanding there is no conflict in the evidence introduced to show what the improvement is and how it differs from what was in the prior art.

In support of its view that the issue whether an alleged improvement required mere mechanical skill or the exercise of invention presents a question to be determined as a matter of law, and not as a question of fact, the Circuit Court of Appeals cited *Heald* v. *Rice*, 104 U. S. 737; *Market Street Railway Co.* v. *Rowley*, 155 U. S. 621; and *Singer Co.* v. *Cramer*, 192 U. S. 265.

These cases hold only that the question of *identity* may be determined as a matter of law. Thus, in *Heald* v. *Rice*, the validity of a reissued patent was challenged on the ground that the reissue patent was not for the same invention as the original patent. In *Market Street R. Co.* v. *Rowley*, the validity of the patent in suit was challenged upon the ground that the inventions and devices described in prior patents disclosed the same invention as that claimed by the patentee. In *Singer* v. *Cramer*, the question in issue was whether the Diehl device, upon which the charge of infringement was based, was substantially the same as that of Cramer.

Where *invention* is in issue, the question to be determined is not one of identity, but whether the differences between the invention and what was in the prior art were of such a character as to require for their production mere mechanical skill or the exercise of the faculty of invention. This Court has held that question to be one of fact.

In *Keyes* v. *Grant*, 118 U. S. 25, there was no dispute as to what differences existed between the furnace disclosed in the patent and the furnaces of the prior art, but this Court held that the question whether the im-

provement required mere mechanical skill or the exercise of invention was one to be decided as a question of fact.

In *Thomson Spot Welder Co.* v. *Ford Motor Co.*, 265 U. S. 445, this Court said (p. 446):

> "The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention, is one of fact; and in an action at law for infringement is to be left to the determination of the jury. *Keyes* v. *Grant*, 118 U. S. 25, 36, 37; *Holmes* v. *Truman* (C. C. A.) 67 Fed. 542, 543; *Hall* v. *Wiles* (C. C.), 2 Blatchf. 194, 11 Fed. Cas. 280, 283; *Poppenhusen* v. *Falke* (C. C.), 5 Blatchf. 46, 19 Fed. Cas. 1052, 1054; *Shuter* v. *Davis* (C. C.), 16 Fed. 564, 566; *Blessing* v. *Copper Works* (C. C.), 34 Fed. 753, 754."

The Circuit Court of Appeals had no power to reverse the judgment of the District Court on the ground that the evidence did not support the challenged findings but required findings leading to the conclusion that the patent was valid and infringed.

The statutes governing review in actions at law tried by a court without a jury, are Sections 649 and 700 of the Revised Statutes (28 U. S. Code, Secs. 773, 875). Section 649 provides:

> "Issues of fact in civil cases in any district court may be tried and determined by the court, without the intervention of a jury, whenever the parties, or their attorneys of record, agree to waive a jury by a stipulation in writing filed with the clerk or by an oral stipulation made in open court and entered in the record. The finding of the court upon the facts, which may be either general or special, shall have the same effect as the verdict of a jury."

Section 700 provides:

> "When an issue of fact in any civil cause in a district court is tried and determined by the court with-

> out the intervention of a jury, according to section six hundred and forty-nine, the rulings of the court in the progress of the trial of the cause, if excepted to at the time, and duly presented by a bill of exceptions, may be reviewed upon a writ of error or upon appeal; and when the finding is special the review may extend to the determination of the sufficiency of the facts found to support the judgment."

The effect of these statutes, as established by repeated decisions of this Court, is that when a case is tried by a court without a jury the finding of the trial court is conclusive upon all matters of fact and prevents any inquiry into any question of law presented by the evidence, unless a request or motion has been made, denied, and excepted to, or some other like action taken which distinctly presented the question of law to the trial court and secured its ruling thereon during the trial. *Arthur C. Harvey Co.* v. *Malley,* 288 U. S. 415; *Mueller Grain Co.* v. *American State Bank,* 275 U. S. 493; *Lewellyn* v. *Electric Reduction Co.,* 275 U. S. 243, 248; *Fleischmann Construction Co.* v. *United States,* 270 U. S. 349, 355-357; *Law* v. *United States,* 266 U. S. 494, 496; *Vicksburg, etc., R. Co.* v. *Anderson-Tully Co.,* 256 U. S. 408, 415; *Wilson* v. *Merchants' Loan & Trust Co.,* 183 U. S. 121, 127; *St. Louis* v. *Western Union Telegraph Co.,* 166 U. S. 388, 390; *Lehnen* v. *Dickson,* 148 U. S. 71, 73; *British Queen Mining Co.* v. *Baker Silver Mining Co.,* 139 U. S. 222; *Boardman* v. *Toffey,* 117 U. S. 271, 272; *Martinton* v. *Fairbanks,* 112 U. S. 670, 673; *Insurance Co.* v. *Sea,* 21 Wall. 158, 161; *Cooper* v. *Omohundro,* 19 Wall. 65, 69; *Insurance Co.* v. *Folsom,* 18 Wall. 237, 248, 249; *Dickinson* v. *The Planters Bank,* 16 Wall. 250, 257; *Miller* v. *Life Insurance Co.,* 12 Wall. 285, 300; *Norris* v. *Jackson,* 9 Wall. 125, 128.

Speaking for the Court in *Fleischmann Construction Co.* v. *United States,* 270 U. S. 349, Mr. Justice Sanford said (pp. 355, 356):

"And it is settled by repeated decisions, that in the absence of special findings, the general finding of the court is conclusive upon all matters of fact, and prevents any inquiry into the conclusions of law embodied therein, except in so far as the rulings during the progress of the trial were excepted to and duly preserved by bill of exceptions, as required by the statute. (Citing cases.)

* * * * * *

To obtain a review by an appellate court of the conclusions of law a party must either obtain from the trial court special findings which raise the legal propositions, or present the propositions of law to the court and obtain a ruling on them. *Norris* v. *Jackson, supra* [9 Wall. 125], 129; *Martinton* v. *Fairbanks,* supra [112 U. S. 670], 673. That is as was said in *Humphreys* v. *Third Nat. Bank,* supra [21 C. C. A. 538, 43 U. S. App. 698, 75 Fed. 852], 855, 'he should request special findings of fact by the court, framed like a special verdict of a jury, and then reserve his exceptions to those special findings, if he deems them not to be sustained by any evidence; and if he wishes to except to the conclusions of law drawn by the court from the facts found he should have them separately stated and excepted to. In this way, and in this way only, is it possible for him to review completely the action of the court below upon the merits.'"

In *Lewellyn* v. *Electric Reduction Co.,* 275 U. S. 243, Mr. Justice Stone stated the effect of the statutes under consideration as follows (p. 248):

"A trial by jury having been waived in writing, our review in this case is limited to the sufficiency of the facts specially found to support the judgment, and to the rulings excepted to and presented by the bill of exceptions, Rev. Stat. §§ 649, 700; *Fleischmann Co.* v. *United States,* 270 U. S. 349, and we are with-

out power to grant a new trial except for error thus presented. *Mueller Grain Co.* v. *American State Bank, post,* page 493, reversing 15 Fed. (2d) 899."

There is also a wealth of decisions by the various Circuit Courts of Appeals holding that appellate courts have no power, in view of the statutes referred to, to make any inquiry as to whether the evidence supports the findings of the trial court or whether the party appealing was entitled to judgment on the ground that the evidence would sustain no other conclusion, unless the point was raised in the trial court and ruled upon during the progress of the trial, and unless proper exception to the ruling was then taken. A partial list of those decisions, arranged by circuits, follows: First Circuit—*Arthur C. Harvey Co.* v. *Malley,* 60 F. (2d) 97; Fourth Circuit—*Peoples Bank* v. *International Finance Corp.,* 30 F. (2d) 46; Sixth Circuit—*General Motors Co.* v. *Swan Carburetor Co.,* 44 F. (2d) 24; *Cleveland* v. *Walsh,* 279 Fed. 57; *Humphreys* v. *Third National Bank,* 75 Fed. 852; Eighth Circuit—*Gerlach* v. *Chicago, R. I., etc., Co.,* 65 F. (2d) 862; *First National Bank* v. *Litteer,* 10 F. (2d) 447; *Allen* v. *Cartan & Jeffrey Co.,* 7 F. (2d) 21; *United States* v. *Atchison, etc., R. Co.,* 270 Fed. 1; *Wear* v. *Imperial Window Glass Co.,* 224 Fed. 60; *U. S. Fidelity, etc., Co.* v. *Board of Commissioners,* 145 Fed. 144; Ninth Circuit—*Gillespie* v. *Hongkong & Shanghai Banking Corp.,* 23 F. (2d) 670; *Macomber* v. *Goldthwaite,* 22 F. (2d) 638; *Phoenix Securities Co.* v. *Dittmar,* 224 Fed. 892; Tenth Circuit—*Davis* v. *United States,* 67 F. (2d) 737; *Greenway* v. *United States,* 67 F. (2d) 738; *White* v. *United States,* 48 F. (2d) 178.

In *Gerlach* v. *Chicago, R. I., etc., Co.,* 65 F. (2d) 862, the case before the Circuit Court of Appeals for the Eighth Circuit was an action at law brought to recover

damages for the alleged infringement of patents. The case was one tried by the court without a jury. At the close of all the evidence, the court made findings of fact and conclusions of law in favor of the defendant, and entered judgment thereon dismissing the action upon its merits. The appellant sought to have the Circuit Court of Appeals pass upon the sufficiency of the evidence to support the findings and conclusions upon which judgment was entered. Holding that it had no power to consider that question, the Court said:

> "Plaintiff made no requests for findings of fact nor conclusions of law, nor was any motion for judgment made by him at the close of the testimony, nor did he take any similar action challenging the rulings of the court. This being an action at law, tried by the court without a jury, the findings of the court upon the facts, have the same effect as the verdict of a jury. 28 U. S. C. A. § 773. The court found that plaintiff's patents were not infringed by the devices used by defendant; that there was no evidence as to the amount of damage, if any, suffered by plaintiff, and, without passing upon the validity of plaintiff's patents, dismissed his action for damages.
>
> "In the assignments of error it is charged that the court erred in making and entering each of its several findings of fact and conclusions of law and in entering judgment. There are certain general assignments to the effect that the court erred in admitting evidence of the defendant 'that was supposed to anticipate the plaintiff's patents and considered the same in the anticipatory nature when as a matter of fact the defendant had failed to comply with the statute in regard to giving proper notice that said patents were going to be used in evidence and that said court failed to consider the patents only for historical purposes and for that purpose only.'

"The assignments which refer to the rulings of the court in admitting or rejecting evidence are all of a general character, and none of them point out any specific or particular ruling of the court, nor do any of these assignments quote the substance of the evidence admitted or rejected; neither do they refer to the page of the printed record where the questioned rulings occur, and it would be impossible to determine from the assignments what particular rulings of the court are sought to be reviewed. So far, therefore, as the assignments are directed to the rulings of the court on the admission or rejection of evidence, they are wholly insufficient to present anything to this court for review. Rules 11 and 24.

"Neither is plaintiff entitled to a review of the court's findings and conclusions because he did not present to the trial court any request for special findings of fact or conclusions of law, and no demurrer challenging the sufficiency or lack of the evidence. Such being the state of the record, no question of fact or law is presented for review because 'the finding of the court upon the facts, which may be either general or special, shall have the same effect as the verdict of a jury.' 28 U. S. C. A. § 773.

* * * * * *

"In the absence of some such action bringing the matter before the trial court, this court cannot consider the sufficiency of the evidence to sustain the judgment * * *

"In this condition of the record the only inquiry open to this court is whether or not the judgment is sustained by the pleadings, findings, and conclusions. Their sufficiency for that purpose is not challenged, and could not be, as they are abundantly sufficient to sustain the judgment entered."

In *General Motors Co.* v. *Swan Carburetor Co.*, 44 F. (2d) 24, the Circuit Court of Appeals for the Sixth Circuit decided that findings of fact as to the scope of a patent claim, made by the trial judge in an action at law for royalties, and tried without a jury, could not be challenged on appeal as without support in the evidence, or upon the ground that the undisputed evidence, as a matter of law, required contrary findings, because the appellant had not secured a ruling on that specific question during the progress of the trial either by motion for judgment or by a request for a declaration of law, excepted to at the time and preserved for review by a bill of exceptions. In a *per curiam* opinion, the Court said:

> "Under the well-settled practice which we are very often being called upon to apply, we cannot review a finding of fact to see whether it is based on any substantial evidence; nor can we examine any question of law, unless the point was distinctly presented to the court below and ruled upon, during the progress of the trial, and unless proper exception was then taken. City of Cleveland v. Walsh (C. C. A.), 279 F. 57; Fleischmann Const. Co. v. U. S., 270 U. S. 349, 46 S. Ct. 284, 70 L. Ed. 624; Law v. U. S., 266 U. S. 494, 45 S. Ct. 175, 69 L. Ed. 401. If there were any specific questions of fact upon which defendant desired findings, it should have presented them to the court below; if it claimed that any specific finding of fact was not supported by any substantial evidence, it should have excepted specifically upon that ground; a general exception to a finding of fact is meaningless The claim that the findings do not support the judgment is, of course, open on such an appeal; but that cannot avail defendant here. It is found as a fact that the structures in dispute were covered by the contract between the parties, and, as a finding of fact, this is about all that could be said in order to support a judgment for an agreed royalty. Defendant

> presents the case very much as if it were an equity appeal, but, when the argument is reduced to terms permissible in a law appeal, it comes to saying that, upon the undisputed facts, the court was required as a matter of law to find no liability; but this position cannot be considered by a reviewing court, unless the defendant has upon the trial proceeded by analogy to a motion for a directed verdict. If made at any time before the trial is finished—and perhaps a trial for this purpose continues until the court announces its conclusion—a request for a conclusion as a matter of law that there is no evidence to support a judgment would be sufficient to preserve this question for our consideration; but no such request was made, and the matter is not open here. Oyler v. Cleveland, C. C. & St. L. R. Co. (C. C. A. 6), 16 F. (2d) 455; May v. Marbury (C. C. A. 6,—Apr. 7, 1930), 39 F. (2d) 438, and cases cited."

It is stated in respondent's brief opposing the petition for writ of certiorari that respondent's complaint was that the District Court had drawn erroneous conclusions and had reached a decision not in accordance with the law upon the admitted facts. Following this, it is stated that: "*proper exceptions were taken to these rulings,* * * *" (Brief of Respondent Opposing Certiorari, p. 12).

The bill of exceptions filed by respondent in the Circuit Court of Appeals (R. 18-156) contains nothing to show that respondent proposed any finding of fact or law, or that there was any insistence that the undisputed evidence compelled the trial court to hold as a matter of law that the patent was valid and infringed. The fact is that there was no challenge to the sufficiency of the evidence to support the findings made by the trial court, no request for a declaration that the patent was valid and infringed or that respondent was entitled to judgment. There was no request made by respondent

for any ruling of law at any time, either before or after the trial, and no exceptions whatever were taken.

There is in the record an order of the District Court sealing the bill of exceptions tendered by respondent. This order recites (R. 156):

> "The said counsel for the said plaintiff did then and there tender this bill of exceptions to the rulings, opinion and action of the said Court, and requested the seal of the Judge aforesaid should be put to the same, * * *".

Respondent cannot rely upon this order and the recital which it contains as showing any exceptions taken at the time to the rulings of the trial court in the progress of the trial. The most that can be said is that the order shows allowance of exceptions contained in the bill of exceptions tendered; but, as already pointed out, the bill of exceptions fails to show that any exceptions were taken to any ruling.

Even if the order and the recital could be construed as allowing exceptions to the findings challenged by respondent's assignment of errors, there could be no inquiry into the question of law sought to be reviewed. The order was not filed until twelve days after the judgment was entered and fifteen days after the trial judge filed his opinion assigning reasons for ordering judgment in favor of petitioners. It was then too late to raise the question whether the evidence required the District Court to find as a matter of law that the patent was valid and infringed. The statute (Revised Statutes, Sec. 700) extends a review to "the rulings of the court in the progress of the trial of the cause, if excepted to at the time." The trial ended in this cause when the judgment was entered for the defendants. *Arthur C. Harvey Co.* v. *Malley*, 60 F. (2d) 97; *United States* v. *Atchison, etc., R. Co.*, 270 F. 1.

In *United States* v. *Atchison, etc., R. Co.*, 270 Fed. 1, the Court of Appeals for the Eighth Circuit passed on this exact question. It was there said (p. 4):

> "Again, the trial ended in this case when, after full hearing and submission of the issues of fact and law on January 24, 1919, the court, after consideration on January 28, 1919, filed its findings of fact and its conclusion that judgment must be entered for the defendant. After that filing it was too late to take exceptions to rulings of the court on the issues tried, and no requests for findings or for modifications of findings were made by the plaintiff until subsequent to the close of the trial. Such subsequent requests and rulings thereon are, like motions for new trials after verdicts and the rulings thereon, discretionary with the trial court, and are not subject to review in the federal appellate courts."

Moreover, a bill of exceptions is not valid as to any matter which was not excepted to at the trial. *Fleischmann Construction Co.* v. *United States*, 270 U. S. 349, 357; *Insurance Co.* v. *Boon*, 95 U. S. 117, 127; *Walton* v. *The United States*, 9 Wheat. 651, 657. And a bill of exceptions cannot incorporate into the record *nunc pro tunc* as of the time when an exception should have been taken, one which in fact was not then taken. *Fleischmann Co.* v. *United States, supra; Walton* v. *United States, supra; Turner* v. *Yates*, 16 How. 14, 29.

Counsel for respondent take the position that the findings challenged by the assignment of errors are special rather than general findings, and insist that the question of law whether the undisputed evidence required the trial judge to find the patent valid and infringed was for that reason open to review, notwithstanding respondent's failure to move for judgment at the close of the evidence, or for a special declaration of law that respond-

ent was entitled to judgment, upon the ground that the evidence supported no other conclusion (Respondent's Brief Opposing Petition for Certiorari, pp. 11, 12).

The findings in question are not special findings. They are part of the opinion of the trial court, constituting a summary of the reasons moving the court to find all the issues in favor of petitioners.

In the paragraph immediately preceding the one in which these reasons are set forth, the trial court invited the parties to submit formal requests for findings, as follows (R. 155):

> "If separate findings of fact are desired the parties may submit requests in accordance herewith."

Respondent requested no special findings and none were made. It is settled that the opinion of the trial judge, dealing generally with the issues of law and fact and giving the reasons for his conclusion, is not a special finding of facts within the meaning of the statute. *Fleischmann Construction Co.* v. *United States,* 270 U. S. 349, 355; *British Queen Mining Co.* v. *Baker Silver Mining Co.,* 139 U. S. 222; *Raimond* v. *Terrebone Parish,* 132 U. S. 192, 194; *Dickinson* v. *The Planter's Bank,* 16 Wall. 250, 257; *Insurance Co.* v. *Tweed,* 7 Wall. 44, 51.

Even if the challenged findings could be regarded as special findings, respondent would not on that account be relieved of the necessity of raising the specific question of law sought to be reviewed. That necessity arises whether the findings are general or special. *Davis* v. *United States,* 67 F. (2d) 737, C. C. A. 10; *People's Bank* v. *International Finance Corp.,* 30 F. (2d) 46, C. C. A. 4; *Gillespie* v. *Hongkong & Shanghai Banking Corp.,* 23 F. (2d) 670, C. C. A. 9; *Macomber* v. *Goldthwaite,* 22 F. (2d) 638, C. C. A. 9; *Gartner* v. *Hays,* 272 Fed. 896, C. C. A. 8; *United States* v. *Atchison, etc., R. Co.,* 270 Fed. 1, C. C. A. 8. In other words where there are no

exceptions to rulings of the trial court during the progress of the trial, the only question open for review upon special findings of fact is whether the facts found support the judgment, and not whether the evidence supports the special findings. *Norris* v. *Jackson,* 9 Wall. 125; *Flanders* v. *Tweed,* 9 Wall. 425; *Miller* v. *Life Insurance Co.,* 12 Wall. 285, 300; *Insurance Co.* v. *Folsom,* 18 Wall. 237; *Booth* v. *Tiernan,* 109 U. S. 205; *Preston* v. *Prather,* 137 U. S. 604; *United States* v. *U. S. Fidelity & Guaranty Co.,* 236 U. S. 512.

Respondent did not seek to raise for review the sufficiency of the findings to sustain the judgment. In any event, it is too clear to require discussion that a judgment for defendant in a suit to recover damages for patent infringement is supported by a finding that the patent is invalid for want of invention and that it is not infringed by defendant's accused device.

It is stated in the opinion filed by the Circuit Court of Appeals that the trial was in substance "a quasi demurrer." It was stated that "no witnesses were examined", and that "there were no disputed facts" to be determined by the trial court.

These statements suggest that the Circuit Court of Appeals may have decided in favor of its power to review the challenged findings upon the ground that the cause was in effect submitted to the trial court upon an agreed statement of facts.

If the case had been submitted to the trial court upon an agreed statement of *ultimate* facts, the sufficiency of such facts to support the judgment would have been reviewable on appeal, for such an agreed statement of facts would be taken as an equivalent of a special finding of facts. *Supervisors* v. *Kennicott,* 103 U. S. 554. But as such equivalent, there must be an agreement upon *all ultimate facts,* and not merely upon collateral facts from which the ultimate facts or any of them may

be inferred. *Wilson* v. *Merchants Loan & Trust Co.*, 183 U. S. 121, 127. And, in any event, the only question open for review would be whether the ultimate facts support the judgment. (See cases cited, supra, p. 21.)

In the instant case, no *additional* witnesses were examined, but the parties offered in evidence the testimony given at the first trial. There was no conflict in the testimony with respect to certain specific collateral facts relating to the prior art, the inventions described in earlier patents, and the nature of the accused devices, but the inferences to be drawn from these auxiliary facts were the subject of dispute, and not agreement. The ultimate facts going to make up the plaintiffs' alleged cause of action and defendants' grounds of defense,—invention, novelty, and infringement,—remained for determination by the trial judge, who decided them in favor of the defendants. It is settled that under such circumstances, an appellate court must accept the findings as conclusive, and limit its inquiry to rulings of law presented by the bill of exceptions. *Wilson* v. *Merchants' Loan & Trust Co.*, 183 U. S. 121, 126-129; *Lehnen* v. *Dickson*, 148 U. S. 71.

It is submitted that the question of law which respondent sought to present by his assignment of errors was one which the Circuit Court of Appeals had no power to consider for the reason that no ruling on that specific question was secured during the progress of the trial, excepted to at the time and preserved for review by a bill of exceptions; and that the judgment in favor of defendants entered by the District Court should have been affirmed.

II.

THE FINDINGS CHALLENGED ON APPEAL ARE WARRANTED BY THE EVIDENCE.

The patent in suit (R. 206) relates to a device for actuating the shutter of a photographic camera. The device is of the type known as cable releases in which two flexible members,—an outer sheath member and an inner thrust member,—one working within the other, and terminating in movable finger pieces, are so connected to the shutter casing and an operating part as to permit the camera shutter to be actuated when the finger pieces are pressed together.

The findings made by the trial court and challenged by respondent's assignment of errors (supra, pp. 4, 5) were, in substance: (1) the cable releases defined in claims 1 and 2 of the patent were anticipated; (2) claims 1 and 2 cannot be construed in the manner urged by respondent to save them from anticipation; (3) the combination of closed coil inner thrust member and open coil outer sheath member which respondent seeks to read into claims 1 and 2 is not patentable in any case; (4) claims 5 and 6 are anticipated, and are, in any event, invalid for want of invention.

The discussion which follows is directed to these findings and to the evidence upon which they rest.

Claims 1 and 2 Are Anticipated.

Claim 1 of the patent (Pltf.'s Exh. No. 1, R. 206, 210) defines a cable release having the following elements in combination:

(a) "Two heads"—these are the two enlargements, one at the inner end of the flexible tube for attachment

to the camera and the other at the outer end of the tube forming the finger grip for the press button.

(b) "A barrel on the outer head"—this is the metal sleeve or barrel marked "A" on Fig. 1-a of the patent, which is screwed into the outer head and lies inside of the fabric tube D and surrounds the short spring marked G.

(c) "A coiled spring wire tube having spaced coils and being located between said heads and engaging said barrel"—this is the coiled spring casing marked C that runs the whole length of the flexible tube and the outer end of which loosely surrounds and engages the reduced inner end of the sleeve or barrel A.

(d) "Flexible means joining said heads and definitely holding them at a fixed distance from each other while said spring wire tube is partially compressed endwise"—this is the fabric tube marked D.

(e) "A stem extending slidably through one of said heads and having limited outward movement"—this is the slide or push button marked F associated with the outer head.

(f) "A slide member in the other of said heads"—this is the slide member marked I on Fig. 1-b of the patent, associated with the inner head.

(g) "And means intervening said stem and said slide member for the transmission of endwise motion from said stem to said slide member"—this is the coiled wire tube J which connects the stem with the slide member and transmits endwise motion from one to the other. *It will be noted that it is here claimed as an element of the patented combination without regard to its particular form,*

whether a coiled wire tube or a straight wire, so long as it connects these two slidable parts and serves to transmit endwise motion from the stem or push button at the outer head to the plunger or slide member at the inner head.

Claim 2 of the patent has the same elements as Claim 1, and in addition it has:

(h) "Yielding means for normally holding said stem at its outer limit"—this is the short coiled spring marked G on Fig. 1-a of the patent. In this claim it is also required that the means intervening between the stem and the slide member for the transmission of endwise motion shall be "joined" to the stem and to the slide member.

At the trial defendants introduced in evidence British patent to *Edwards & Watson;* No. 5,741 of 1906* (Deft.'s Exh. 18, R. 322).

In Figure 2 of this patent, which illustrates a release mechanism for photographic cameras, all of the elements of Claim 1 as well as Claim 2 of the patent in suit are disclosed in the same combination and for the same purpose, as follows:

(a) "Two heads"—the outer head constituting the finger grip of the press button and illustrated at the left hand end of the figure at A, and the inner head illustrated at the right hand end of the figure at B.

(b) "A barrel on the outer head"—this is the metal sleeve of barrel marked f on the drawing, which lies inside of the fabric tube of casing marked b, and surrounds the short spring marked a^x.

*In addition to the patent itself, a chart was submitted to the trial court in which the elements of claims 1 and 2 of the patent in suit were identified on Fig. 2 of this patent. A copy of the chart accompanies this brief.

(c) "A coiled spring wire tube having spaced coils and being located between said heads and engaging said barrel"—this is the coiled spring marked g that runs the whole length of the fabric tube and engages the inner cup-shaped end of the sleeve or barrel f.

(d) "Flexible means joining said heads and definitely holding them at a fixed distance from each other while said spring wire tube is partially compressed endwise" —this is the fabric tube marked b.

(e) "A stem extending slidably through one of said heads and having limited outward movement"—this is the slide or push button marked k associated with the outer head.

(f) "A slide member in the other of said heads"— this is the slide member marked l associated with the inner head.

(g) "And means intervening said stem and said slide member for the transmission of endwise motion from said stem to said slide member"—this is the straight twisted wire marked i which connects the stem with the slide member and transmits endwise motion from the stem at the outer head to the slide member at the inner head.

(h) "Yielding means for normally holding said stem at its outer limit"—this is the short coiled spring marked a^x.

A comparison of the cable release illustrated by Figure 2 of the *Edwards & Watson* patent with the cable releases defined by Claims 1 and 2 of the patent in suit was made by the witness Christy (R. 107-109). At the end of that comparison the following testimony was given:

"Q37. Then do you find, Mr. Christy, in this British patent to Edwards of 1906 the same elements that are claimed in claims 1 and 2 of the plaintiff's patent, arranged in the same combination, for the same purpose?

A. I do."

This evidence fully warranted the comment of the trial Judge that these claims, "if read as stated, made a combination which was clearly anticipated by the British patents" (R. 153).

The respondent did not attempt to deny that Claims 1 and 2, if read as stated, are anticipated by *Edwards & Watson*. He seeks to avoid anticipation by interpreting the words "means intervening said stem and said slide member" as though they read "a coiled wire tube intervening said stem and said slide member". This contention was answered by the trial Judge in conclusion numbered 2, discussion of which follows.

Claims 1 and 2 Cannot Be Interpreted as Calling for a Closed Coil Inner Thrust Member in View of the File Wrapper History of This Patent.

The "reasons why" the trial Judge came to this conclusion are set forth in his opinion as follows (R. 153, 154):

"These claims do not call for a coiled tube as an inner member but merely for 'means intervening * * * for the transmission of endwise motion,' and, if read as stated, made a combination which was clearly anticipated by the British patents. Only by reference to the specification can the claim be narrowed to a claim for a coiled tube inner member. The file wrapper history, however, shows that another claim (original claim 17) identical in all re-

spects with claim 1 (and substantially identical with claim 2) except for the fact that it called for a 'coiled wire tube' instead of 'means intervening' was disallowed by the examiner, as so anticipated. The plaintiff then amended by including a 'barrel' feature in both claims and claim 1 was allowed. Claim 17 was again rejected 'as not patentably distinct from claims 1 and 4 allowed.' In this action the plaintiff acquiesced.

"The case is so nearly on all fours with U. S. Repair, etc., Company v. Assyrian Asphalt, 183 U. S. 591, that the opinion in that case may be applied to this with a very little paraphrasing, thus: 'Another objection to the proposed limitation of the claim by making it read * * * ("a coiled wire tube") * * * in lieu of the unqualified word * * * ("means") * * * is the fact that the * * * ("17th") * * * claim, which contained the additional words, was withdrawn by the patentee upon a ruling or declaration of the Patent Office that the 1st and * * * ("17th") * * * claims were the same in substance and could not both be permitted to remain in the case * * *. Having voluntarily abandoned the claims for * * * ("a coiled wire tube") * * * the patentee * * * may not now insist that a broad claim containing no suggestion of such invention shall nevertheless be subjected by construction to the same restriction.'"

To establish the facts above recited regarding Gray's presentation of a claim identical with Claims 1 and 2 except for the fact that it called for a "coiled wire tube" instead of "means intervening," and his acquiescence in the rejection of the claim by the Patent Office, appellants introduced in evidence the file wrapper history of Gray's application (Deft.s' Exh. No. 1, R. 231) from which it appears:

Claim 17 in Gray's application as originally filed was in the following words (R. 245):

> "In a mechanism of the nature described, the combination of two heads, a coiled spring wire tube having spaced coils and being located between said heads, flexible means joining said heads and definitely holding them at a fixed distance from each other while said spring wire tube is partially compressed endwise, a stem extending slidably through one of said heads and having limited outward movement, a slide member in the other of said heads, and a coiled wire tube intervening and joined to said stem and said slide member for the transmission of endwise motion from said stem to said slide member, substantially as described."

Under date of February 25, 1918, the examiner rejected this claim 17, and several other claims of like import, in the following words (R. 251, 252):

> "Claims 17 to 22 inclusive are rejected on the British patent to Edwards cited:* *To construct the transmission element of a coiled wire tube is not patentable* in view of—German to Wermann, 147,572, June 23, 1904, (64-30-B. M.) (1 sheet)." (Italics ours.)

The applicant did not contest this rejection, nor insist upon a claim for the subject-matter which he, and his counsel, now present as the subject-matter patented in his patent.

On the contrary, respondent amended claim 17, and the related claims rejected at the same time, by inserting in each of them a limitation to a camera release structure having *"a barrel"*, on the outer head and *engaged by the "coiled spring wire tube"* or open coil casing. He inserted after the word "heads" in the third line of the claims, the words "and engaging said barrel" (R. 255). Such a barrel was not found in the Watson

*The patent referred to is the British patent to Watson & Edwards No. 13,157 of 1905.

& Edwards British patent No. 13,157 of 1905 cited by the examiner. But such a barrel is found in the Edwards British patent No. 5,741 of 1906 (supra, p. 25).

The examiner, apparently not aware of the British patent of 1906, was willing to allow claims the patentability of which was predicated on the inclusion of the barrel in the combination claimed, such as claims 1 and 2 of the plaintiff's patent as issued. *But in allowing such claims the examiner again ruled that the use of a coiled wire tube for the "intervening means" is not patentable; and the applicant again acquiesced.* The history of this is as follows:

Claims 1 and 2 of the patent as issued are, in amended form, original claims 1 and 4 of the application as filed.

These original claims 1 and 4, with others, were rejected in the first patent office action (R. 251) on the British patent to Watson & Edwards, No. 13,157 of 1905, and the United States patent to Edwards, No. 929,573 of 1909. Neither of these patents shows the barrel on the outer head engaged by the open coil outer casing. Both of the original claims 1 and 4 defined the thrust member as they now define it—that is, broadly as "means intervening said stem and said slide member for the transmission of endwise motion from said stem to said slide member."

In the first amendment the applicant amended claims 1 and 4 by inserting the words "a barrel on the outer head" in lines 2 and 3 of claims 1 and 2 as printed in the patent, and the words "and engaging said barrel" in line 5 of claims 1 and 2 as printed (R. 253). So amended, these claims became claims 1 and 2 of the patent.

The applicant said (R. 256):

> "The references do not show the barrel and the coiled wire tube engaging the barrel, as now made elements in claims 1 to 9, 11 and 12",

and

> "Claims 17 to 22, inclusive, have been amended to include the barrel and to specify that the outer spring tube engages, features not present in the references."

Thereupon the examiner, not knowing of the British patent to Edwards of 1906, and therefore erroneously supposing that a barrel engaged by the outer coiled spring wire tube was new, allowed claims 1 and 2 (then claim 4), but he said (R. 258):

> "Claims 17 to 22 are rejected as not patentably distinct from claims 1 and 4, allowed. The *use of the 'coiled wire tube' for the 'intervening means' defined in claim 1 is not patentable in view of the German patent of record.* In other words—applicant merely adds a limitation found in the prior art—to allowed claims which is not patentable." (Italics ours.)

The applicant thereupon cancelled claims 17 to 22, inclusive (R. 259).

In the District Court, and in the Circuit Court of Appeals, respondent did not dispute the facts, but contended that his acquiescence in the rejection of claim 17, wherein the phrase "a coiled wire tube" was substituted for the unqualified word "means" of claims 1 and 2, does not preclude a construction of the latter claims which would make them identical with, and give him the benefit of, the rejected claim. The contrary, however, is established by the decisions of this Court in *Morgan Envelope Co.* v. *Albany Paper Co.*, 152 U. S. 425, and *United States Repair, etc., Co.* v. *Assyrian Asphalt Co.*, 183 U. S. 591.

In the *Morgan Envelope* case suit was brought upon three separate patents granted to Oliver H. Hicks; one for a package of toilet paper; another for a toilet paper

fixture; and a third for an apparatus for holding toilet paper. The Court decided, however, that the defendants could not be held as infringers unless the patent for the toilet paper was valid. This patent set forth its claim of invention in the following language:

> "a bundle of paper consisting of one or more lengths formed into a continuous band whose internal diameter is greater than the thickness of the paper, substantially as described."

The invention in question, as described in the specification and illustrated in the drawings annexed to the patent, was for a band of paper rolled in an oval instead of the usual cylindrical shape. In the specification the patentee stated that he had in view to furnish a toilet paper in the form which would prevent wastage and said:

> "In carrying out this object I have put up one or more lengths of paper in the form of a continuous band (as contradistinguished from a roll) of oblong or oval shape, the short rounded ends of the bundle thus produced serving as guides for determining the proper points at which the paper has to be separated in order to produce sheets of a size desirable for use, and affording also the most advantageous surfaces upon which to tear the paper."

The plaintiff insisted that under the words "substantially as described" the patentee was entitled to claim a band of oval or oblong shape, and that looking at the specification and drawings in connection with the claim, it was obvious that the latter should be so limited. But the patentee's original application contained a claim for

> "a bundle of toilet paper consisting of one or more lengths of paper formed into a flexible continuous band of oblong or oval shape, the short rounded

ends of such band serving as guides for determining the proper points at which the paper is to be separated in order to produce sheets of a size desirable for use, and affording, also, the most advantageous surfaces upon which to tear the paper, substantially as described."

This claim, it will be seen, corresponded with the specification and drawings, and was Hick's real invention. The patent office rejected this claim as indefinite, because it did not point out any construction different from an ordinary paper roll, and also rejected it upon a prior patent. The patentee thereupon amended his application by changing his claim to read as above set forth. It is manifest that the claim made in the original application was narrower in scope than that substituted therefor after its rejection; but the Supreme Court held that nevertheless the patentee, having relinquished it for a broader claim, could not have the latter construed so as to give it the limited scope of the former.

Mr. Justice Brown, in delivering the opinion of the Court said (p. 429):

"It is insisted in this connection, however, that under the words 'substantially as described' the patentee is entitled to claim a band of oval or oblong shape, and that, looking at his specification and drawing in connection with the claim, it is obvious that the latter should be so limited. But the patentee having once presented his claim in that form, and the Patent Office having rejected it, and he having acquiesced in such rejection, he is, under the repeated decisions of this court, now estopped to claim the benefit of his rejected claim or such a construction of his present claim as would be equivalent thereto. *Ledgett* v. *Avery*, 101 U. S. 256; *Shephard* v. *Carrigan*, 116 U. S. 593; *Crawford* v. *Heysinger*, 123 U. S. 589, 606; *Union Metallic Cartridge Co.* v. *United States Cartridge Co.*, 112 U. S. 624.

> It is true that these were cases where the original claim was broader than the one allowed, but the principle is the same if the rejected claim be narrower."

The general rule of file wrapper estoppel was there applied to the situation presented by the instant case, where the rejected claim was narrower than the allowed claim, and plaintiff now attempts to restrict the allowed claim by reference to the words "substantially as described."

The *Assyrian Asphalt Co.* case, paraphrased by the trial judge in his opinion, involved a patent granted to secure the invention of Amos Perkins, entitled "an improved method of repairing asphalt pavements." The claim in issue was as follows:

> "1. The method of repairing asphalt pavements, which consists in subjecting the spot to be repaired to heat, adding new material and smoothing and burnishing it, substantially as described."

The specification of the patent sued upon, in describing the patentee's apparatus, stated explicitly that its burners were made "to project a flame downward against the pavement" and "to produce a blast by means of an air-pump"; and further on the mode of operation was said to be such that "a strong blast of heat is projected against the surface of the asphalt."

But in the course of the pendency of the application for the patent the applicant had been required by the patent office examiner to elect between the first claim, hereinabove quoted, and a third claim which was couched in precisely the same language except that it contained the phrase "a strong blast of heat" instead of the single word "heat" on the ground that the two claims "are the same in substance, differing only in degree, and both

cannot be permitted to remain in the case" (100 Fed. 966).

Accordingly the applicant withdrew the third claim; and the Court held that the retained first claim could not be construed to have the same meaning as the one thus abandoned.

Mr. Justice McKenna in delivering the opinion of the Supreme Court quoted with approval the following ruling of the Circuit Court of Appeals for the Seventh Circuit in the opinion delivered by Judge Woods:

> "Another objection to the proposed limitation of the claim by making it read 'a blast of heat', or 'a strong blast of heat', in lieu of the unqualified word 'heat', is in the fact that the third claim, which contained the additional words, *was withdrawn by the patentee upon a ruling or declaration of the Patent Office that the first and third claims were the same in substance and could not both be permitted to remain in the case.* That was not merely a casual expression of opinion by an examiner, but was in effect a requirement that one or the other of the claims be withdrawn, and no reason is perceived for not applying the ordinary rule. Having voluntarily abandoned the claim for a method limited to the use of 'a blast of heat', the patentee or his assignee may not now insist that a broad claim, containing no suggestion of such intention, shall nevertheless be subjected by construction to the same restriction." (Italics ours.) (P. 601.)

The Circuit Court of Appeals held that the phrases "in a mechanism of the nature described", and "substantially as described", used in claims 1 and 2, qualify the word "means" and require the claims to be construed as calling for "a coiled wire tube", the only means for transmitting endwise motion shown in the specification and patent drawing.

There is no discussion in the opinion delivered by the Circuit Court of Appeals of the decision of this Court in the *Assyrian Asphalt Case*, particularly relied upon by the trial court, nor is there any discussion of the *Morgan Envelope Case*, urged upon the Circuit Court of Appeals by petitioners as dispositive of the point under consideration.

In rejecting the conclusion of the District Court that the file wrapper history of the patent precluded such construction, the Circuit Court of Appeals merely said (R. 179, 180):

> "We limit ourselves to saying we find nothing in the proceedings in the patent office to affect the validity of Gray's claims. His original application had an undue number of claims and duplications in many cases, and these were cut down. * * * Such device was not shown in the cited prior patents and, therefore, required no modification of the claims, and these claims were never modified beyond a minor change in adding an omitted element, viz.: 'a barrel in the outer head.' "

The finding of the District Court was not based upon the idea that the cancellation of a claim which is substantially identical with an allowed claim affects the *validity* of the latter. It was based upon the view that the restriction to a "coiled wire tube" which appeared in cancelled claim 17 cannot be read into the allowed claims which do not mention any such restriction.

> *The combination of a closed coil inner thrust member and open coil outer sheath is not patentable because its elements were known to the prior art and no new mode of operation or functional relationship arises from putting them together.*

The idea of making the outer sheath member and the inner thrust member of cable releases of coiled wire

tubes is disclosed in the earliest patents for cable releases. The earliest of all the patents in evidence, the German patent to Wermann, of 1902, shows both the thrust member and the sheath constructed in this fashion (R. 332).

The claim is made for the patentee, however, that he first invented the combination of a closed coil wire tube for the thrust member and an open coil wire tube for the sheath. By a closed coil is meant one in which the spirals are in contact throughout so that the whole is incompressible lengthwise. In an open coil the adjacent spirals are spaced. It is urged that this combination of closed inner and open outer coils is the essence of Gray's invention, and his real contribution to the art (Gray, q. 33, 90, R. 30, 40; Mr. White, R. 44, 45).

The use of closed coil wire thrust members in cable releases for the purpose of obtaining greater flexibility was proposed by Wermann and the structure was clearly illustrated and described in his German patent No. 147,572, May 28, 1902 (R. 332). A similar disclosure is found in the Dakin U. S. patent No. 1,297,327, filed October 15, 1917, prior to Gray's application (R. 298), and releases substantially as illustrated in the Dakin patent were made by the Eastman Kodak Co. prior to Gray's application (R. 100).

The specification of Edwards' British patent No 13,157 expressly recognizes that an open coil outer member is an old feature of photographic cable releases and had been used before in combination with an incompressible inner member (R. 302).

The use of open coil outer sheath members in cable releases for the purpose of attaining greater flexibility was proposed by Edwards, and the structure illustrated is described in his British patents, Watson & Edwards No. 13,157 of 1905; Edwards & Watson No. 15,645 of 1905; and Edwards & Watson No. 5,741 of 1906 (R. 302,

309, 322). Large quantities of cable releases made in accordance with the disclosure of Figs. 1 and 2 of Edwards & Watson No. 5,741 of 1906 were sold in this country years before Gray's application (R. 105).

The question is thus presented whether an assembly of two selected elements, both old and well known, required the exercise of the faculty of invention. On this point the trial court said:

> "Taking the question in its broadest aspect and assuming, as the plaintiff contends, that all the claims (including 1 and 2) can be so construed as to include the combination which he says constitutes his real invention, I am satisfied that it amounts to nothing more than an assembly of two selected elements, neither of them new, without any new joint function, and hence is unpatentable. Of course, they cooperate and whoever first combined a flexible inner thrust member with a flexible outer sheath in a cable release may have produced a real invention, but when that had been done, and especially after coiled wire tubes had been evolved for both members, the selection of superior forms of coils from the prior art produced no new result as the product of the combination. Whatever advance there may have been was simply an aggregate of several results, each the complete result of one of the combined elements. The principle is too well established to require citation of authority."

The position of the trial judge on this point is amply supported by authority: *Hailes* v. *Van Wormer,* 20 Wall. 353; *Concrete Appliances Co.* v. *Gomery,* 269 U. S. 177; *Grinnell Washing Machine Co.* v. *Johnson Co.,* 247 U. S. 426; *Richards* v. *Chase Elevator Co.,* 158 U. S. 299; 159 U. S. 477; *Duer* v. *Corbin Lock Co.,* 149 U. S. 216; *Pope Mfg. Co.* v. *Gormully,* 144 U. S. 254; *Busell Trimmer* v. *Stevens,* 137 U. S. 423; *Holland* v. *Shipley,*

127 U. S. 396; *Pickering* v. *McCullough*, 104 U. S. 310. The latest pronouncement of this Court on this subject is found in *Electric Cable Joint Co.* v. *Brooklyn Edison Co.*, decided April 2, 1934.

The reasons advanced by the Circuit Court of Appeals for arriving at a different conclusion may be summarized as follows:

(a) Gray's device is superior to other types of cable releases (R. 174);

(b) In the Gray release there is a different co-action between the closed coil inner thrust member and the open coil sheath member from that which is obtained between the outer and inner coils of earlier flexible releases (R. 176);

(c) All attempts of earlier workers in the field to produce a satisfactory cable release had met with failure (R. 167-170);

(d) The presumption of invention arising from the grant of the patent (R. 174);

(e) The adoption of Gray's device by petitioners after Gray had shown them the structure (R. 176).

(f) The contention of lack of invention was an afterthought with petitioners (R. 172).

The fact that a more satisfactory release is obtained by using a closed coil inner thrust member and an open coil outer sheath member cannot be given weight in determining the question of invention, where the satisfactory result obtained is merely the sum of the results flowing from the use of each element separately. A superior result is not a new result in the patentable sense.

In practically every case in which this Court has held a device unpatentable on the ground that it was an aggregation, the superior utility has been urged without effect. In *Grinnell Washing Machine Co.* v. *E. E. Johnson Co.*, 247 U. S. 426, 434, this Court said:

> "Phillips may have produced a more convenient and economical mechanism than others who preceded him, but superiority does not make an aggregation patentable."

The idea that in Gray's release there is a different co-action between the closed coil inner thrust member and the open coil sheath member from that which is obtained between the outer and inner coils of earlier flexible releases does not rest upon any evidence in the record. On the contrary, the evidence (Wermann's German patent, R. 332; Dakin & Underwood's U. S. patent, R. 298) fully supports the following statement made on that point by the trial court (R. 152):

> "However, his [Gray's] closed coil thrust member still transmitted power in exactly the same way in which it did in the Wermann patent and the Dakin & Underwood patent, and the fact that it was enclosed in an open coil instead of a closed coil did not change its mode of operation. The open coil sheath member flexed in precisely the same manner as in the various British patents which disclose its use, and it would do so whether the thrust member were a coiled tube, a stranded wire, or a plain wire. I am unable to see how the advantages of the particular types selected by the plaintiff for each of these members are enhanced or in any way affected by the character of the other member, or to find anything new in the functional relationship between them."

The statements found in the opinion of the Circuit Court of Appeals to the effect that earlier workers had failed to produce a satisfactory cable release (R. 166-170) and that "up to 1917 * * * a great company like Eastman, with its skilled engineers, continued to use the rubber bulb with the pneumatic push" (R. 169) are without the slightest support in the evidence.

Large quantities of cable releases made in accordance with the disclosures of the Edwards and Watson English patent No. 5,741 of 1906, were imported and sold in this country from 1907 to 1914 (R. 105).

Shutter actuating devices of the cable release type have been made and sold in large quantities by Eastman Kodak Company continuously since before 1913 (R. 100, 106).

If it were permissible to characterize these devices as failures, Gray's device could properly be called a failure the moment a superior cable release appeared.

Nor is it true, as stated in the opinion of the Circuit Court of Appeals (R. 173), that the Eastman Company ceased making other types of shutter actuating devices after Gray's device was sent to it and examined. The undisputed testimony is that the manufacture of other types of cable releases continues today (See Physical Exhibits).

In any event, the argument based upon these inaccurate statements merely comes to saying that a cable release with a closed coil inner thrust member and an open coil outer sheath member gives a more satisfactory performance than the devices shown in earlier patents. The validity of this argument has been discussed above.

The opinion of the Circuit Court of Appeals contains the remarkable statement that the question whether the substitution of a coiled wire tube as the inner thrust member element of a cable release having an open coil outer sheath member involved invention was decided in

favor of the patentee by the Patent Office, and the further statement that "the trial judge failed to give due weight to the presumption of invention arising from the grant of the patent" (R. 174).

We have hitherto pointed out that the Patent Office, far from holding that that substitution involved invention, expressly held that the use of a coiled wire tube for the intervening means is not patentable and rejected claim 17 which claimed what the Circuit Court of Appeals now holds to be Gray's invention (*supra*, pp. 29, 31; R. 251, 252, 258).

Whether Eastman Kodak Company first obtained knowledge of or made the accused releases after learning of Gray's activities is immaterial on the question of invention. It happens, however, that the Eastman Company did not derive knowledge of the accused releases from Gray.

The Eastman Company was fully aware of the advantages and had planned the production of a release embodying both a coiled wire thrust member and a spaced coil outer casing and had made a drawing showing them in combination before it had ever heard of Gray or of his cable release.

On June 21, 1918, one Joseph Knafft, acting for Gray, wrote a letter to Mr. H. M. Fell of the Eastman Company (Pltf.'s Exh. 4, R. 212) calling attention to a cable release said to be more flexible than those then in use, and on July 2, 1918, he sent to Fell (Pltf.'s Exh. 8, R. 214) a model of the release in question. As this was Gray's first approach, it was not until July 3, 1918, that the Eastman Company had any knowledge whatever of Gray and his release. We shall now review briefly Eastman's work in the development of its present release prior to that time.

In 1913 the Eastman Company was equipping its cameras with cable releases in which the thrust mem-

ber was in the form of stranded wire cable and the outer member or casing in the form of a tightly wound coil (R. 106). A drawing of this early type of releases was received in evidence (Deft.'s Exh. 16, R. 285).

On December 24, 1915, Mr. J. A. Robertson, then superintendent of the Eastman Camera Works wrote a letter to Mr. C. L. Jenks, head of the Patent Department (Deft.'s Exh. 12, R. 282) transmitting a sample of a new type of release "in which the push cable is made of wound spiral coils, the same as the casing. This is much more flexible than the cable we have in use. The suggestion came from one of our employees, Ed. Dakin on August 31, 1915". On October 15, 1917, an application for a U. S. patent disclosing this release was filed in the name of E. W. Dakin and E. E. Underwood, this application maturing as Patent No. 1,297,327 (Deft.'s Exh. 13, R. 298) on March 18, 1919, and is the Dakin patent referred to before in this brief. On July 19, 1917, instructions in the form of a "pink slip" or note No. 91 (R. 89), were issued by the Production Manager to the manufacturing departments notifying them that a "new model cable release has been designed using a wire wound cable" and on August 13, 1917, another "pink note," No. 91a (R. 89) was issued specifying the orders in which this change was to become effective. There can, therefore, be no doubt that as early as 1915 the Eastman Company was aware of the advantages of a coiled wire thrust member and that by the summer of 1917 releases embodying this type of thrust member were in production.

On April 12, 1916, Mr. Robertson again wrote Mr. Jenks (Deft.s' Exh. 11, R. 281) enclosing a sample release "having an open flexible spring (outer casing) instead of a close wound one" and asking that Mr. Jenks get the opinion of the company's British patent solicitor, Mr. J. T. Clarke, as to whether the releases provided with that form of casing could be exported to Europe.

Mr. Clarke reported that this release if sold in England would infringe one of the Edwards British patents (Perrins, R. 102). On April 27, 1918, a "pink slip," No. 333 (R. 90, 91) was issued by the Production Department notifying the manufacturing departments of "changes being made in all of the spring casings used in our cable releases, some being open wound instead of close wound as at present. New part lists are being written * * * to be used on all local orders for releases, the present lists being reserved for London orders only until June 26, 1919, when we can safely ship the new releases to Europe without infringing on English patents. Great care must be exercised to see that any releases shipped to Europe before the date above mentioned have a close wound casing. Change takes effect on all new orders in the works."

Thus, as early as May 14, 1918, six weeks before Gray submitted his sample release to the Eastman Company, "pink slips" had been issued by the Production Department ordering these two changes in cable release construction (1) the substitution of a coiled wire thrust member for the old stranded wire cable ("pink slips," 91 and 91a) and (2) the substitution of a spaced coil casing for the tightly wound casing on all domestic orders ("pink slip," 333).

If further proof were required that the Eastman Company had contemplated the manufacture of releases embodying both the coiled wire thrust member and the spaced coil casing it may be found in Camera Works drawing No. 15,132, dated May 14, 1918 (Deft.s' Exh., R. 273) and checked by J. E. Seigfried (R. 86). The original of this drawing which plaintiff offered in evidence (Pltf.'s Exh. 44, R. 230) was changed in later years in accordance with the practice of the Drafting Department, but the photostat which defendant offered in evidence (Deft.s' Exh. 4, R. 273) is the original photo-

graphic record of the drawing before those changes were made.

In the opinion delivered by the Circuit Court of Appeals, the following statement is made (R. 172):

> "the contention of lack of invention was evidently an afterthought, for at the first trial no such contention was made. In that regard, at the jury trial, the Judge stated to the jury: 'I have called your attention to these three elements—invention, utility; novelty. Invention, as I understand it, is not in real controversy here. So you need not trouble yourselves about it.'"

The issue of lack of invention was duly raised at the first trial by defendant's points for charge, numbered 19, 20, 22, 24, 25 and 27 (R. 142, 143, 144). The quoted remarks of the trial judge in charging the jury were taken as a denial of these requests and exceptions thereto were taken by defendants in accordance with his statement at the end of the general charge that the points submitted were disaffirmed so far as not affirmed in the general charge (R. 131). As a matter of fact, the withdrawal of the issue of invention by the trial court was vigorously urged as a reason why the verdict rendered by the jury should be set aside.

Claims 5 and 6 Are Invalid Because United States Patent No. 1,297,327 to Dakin and Underwood Antedating the Plaintiff's Application Discloses the Method of Attaching the Thrust Member to the Stem Claimed, and Conclusion "1" Applies to These Claims.

Claims 5 and 6 are predicated upon the way in which the stem and slide member, respectively, are connected to the ends of the coiled wire thrust member. Claim 5

is exactly like the rejected claim 17 except for the added words "and adjustably joined" in the twelfth line of the claim. Claim 6 is exactly like the rejected claim 17 except for the words "and threaded to" in the twelfth line of that claim. Referring to the connection defined in this claim, the plaintiff himself said: "That was only a minor feature of the machine"; "only a side issue" (Gray, R. 56, 57).

It is charged that the connection of the stem and of the slide member to the coiled wire cable in defendants' structures infringes these claims. In discussing this issue, the trial judge said:

> "The patent to Dakin and Underwood shows a method of joining the thrust member to the stem which is substantially the same as that of the alleged infringing device."

The patent referred to is United States patent No. 1,297,327 (Deft.s' Exh. 18, R. 298). It concededly antedates Gray. Hence, claims 5 and 6 are anticipated if construed to cover the alleged infringing devices. If the means of connection in appellees' devices is not an adjustable or threaded connection within the meaning of claims 5 and 6, the claims are not infringed.

The method of joining the thrust member to the stem employed in the accused structure is shown by an X-ray photograph (Deft.s' Exh. 17, R. 286). Examination of this photograph shows the sleeve or tip is fixed by a prick punch in exactly the way described by the Dakin patent. The manner in which the thrust member is joined to the stem at the Eastman factory is detailed in the record (Christy, R. 112, 113).

Appellees at the trial also submitted in evidence United States patent to Duryea No. 1,072,439 (Deft.s' Exh. 18, R. 294) which shows at 10 and 11 on Fig. 2 a screw threaded, adjustable, connection for connecting the two

ends of the thrust member to the handle lever 6 at one end and to the associated member 8 at the other end.

British patent to Edwards and Watson, No. 15,645 of 1905 (Deft.s' Exh. 18, R. 309) also discloses the way in which the stem and slide member are secured to the intervening coiled wire tube in Eastman's devices. That patent says, at page 1, lines 17 to 24, inclusive, and again at page 4, lines 10 to 17, inclusive:

> "The innermost member may be formed of one or more wire or wires of stranded wires or of wires held together by wire coiled around them or a closely coiled spiral and is attached at one end to a push button or push piece—for example passed at one end into the sleeve or shank thereof and there secured by compressing or denting said sleeve at one or more points—this push button or push piece being adapted to slide within or otherwise operate in conjunction with the first named sleeve to which the outermost member is attached as aforesaid."

In disposing of respondent's argument that Dakin and Underwood did not anticipate claims 5 and 6, the trial judge said (R. 155):

> "The argument made by the plaintiff that the two prick points disclosed in the Dakin drawing deform the coils of the thrust member and prevent it from being screwed out is without support in the record, and the fact that Dakin uses the word 'fixed' in describing his method of attachment does not necessarily mean that the stem is so fixed that it cannot be unscrewed. The connection of the infringing device is a single prick point and it is rather hard to see from an X-ray photograph to what extent it deforms the coils of the thrust member if at all, but, taking the substance of the matter, that type of connection is clearly disclosed by Dakin."

What has been said above regarding the unpatentable nature of the assembly of a closed coil inner thrust member and an open coil outer sheath member renders unnecessary any discussion of the further conclusion of the trial judge that Claims 5 and 6, in any event, define a mere aggregation, and are for that reason invalid.

CONCLUSION.

It is therefore respectfully submitted that the Circuit Court of Appeals had no power to review the findings challenged by respondent's assignment of errors; that the conclusions challenged by the assignment of errors were warranted by the evidence; that the judgment entered by the District Court is supported by the facts found by the trial judge; and that the judgment of the Circuit Court of Appeals for the Third Circuit should be reversed and the judgment of the District Court affirmed.

Respectfully submitted,

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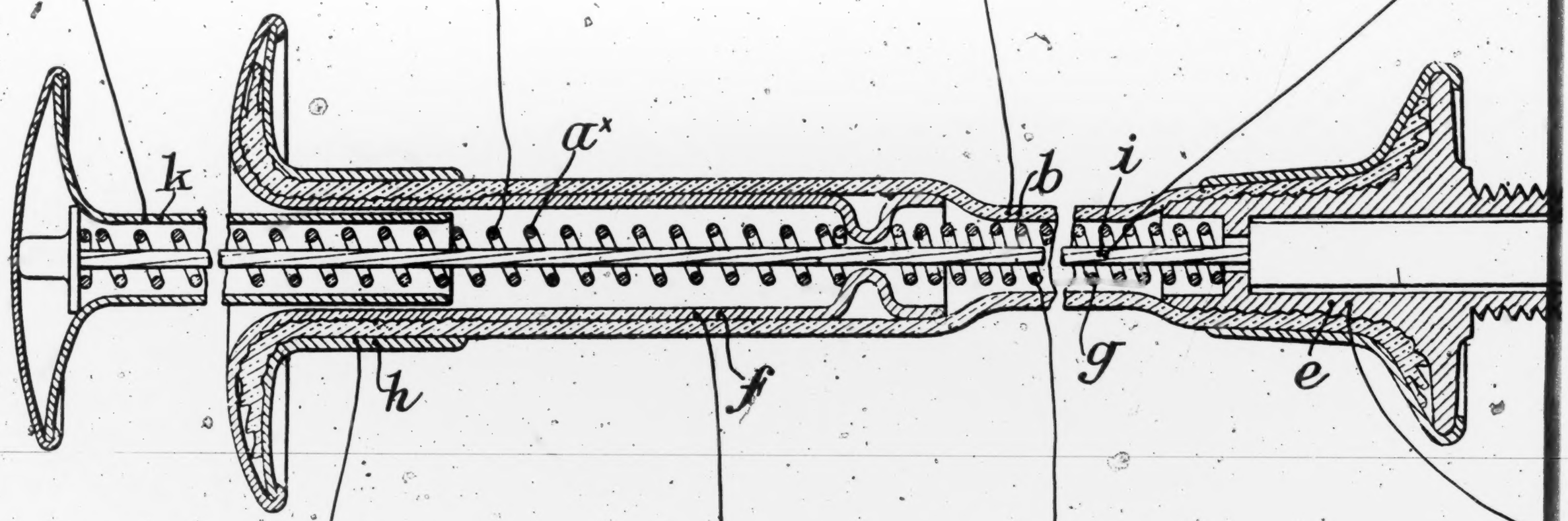
FIG. 3 OF EDWARDS & WATSON BRITISH PATENT
NO. 5,741 of 1906,
With Elements of Gray's Claims 1 & 2 Applied to
Corresponding Parts.

(5) The stem (k) extending slidably through one of said heads and having limited outward movement

(8) Yielding means (a^x) for normally holding said stem at its outer limit

(4) Flexible means (b) joining said heads and definitely holding them at a fixed distance from each other while said spring wire tube is partially compressed endwise

(7)

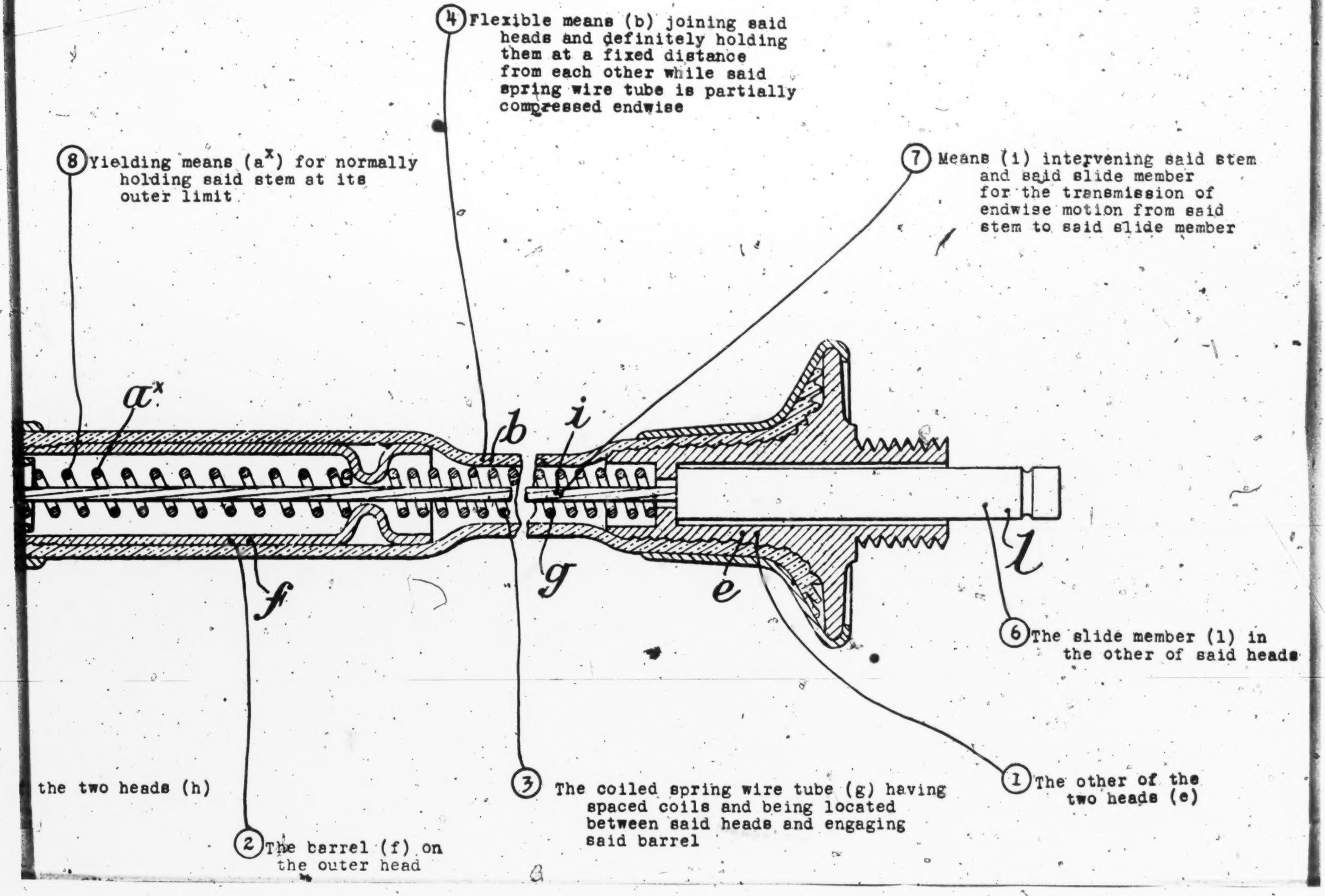


(1) One of the two heads (h)

(2) The barrel (f) on the outer head

(3) The coiled spring wire tube (g) ha spaced coils and being located between said heads and engaging said barrel

NO. 5,741 of 1906,
With Elements of Gray's Claims 1 & 2 Applied to Corresponding Parts.


8 Yielding means (a^x) for normally holding said stem at its outer limit
4 Flexible means (b) joining said heads and definitely holding them at a fixed distance from each other while said spring wire tube is partially compressed endwise
7 Means (i) intervening said stem and said slide member for the transmission of endwise motion from said stem to said slide member
a^x
b
i
g
e
f
l
6 The slide member (l) in the other of said heads
the two heads (h)
2 The barrel (f) on the outer head
3 The coiled spring wire tube (g) having spaced coils and being located between said heads and engaging said barrel
1 The other of the two heads (e)